

REMARKS

The non-final Office Action mailed July 21, 2008 has been reviewed, and these remarks are responsive thereto. The current Office Action rejects claims 57-79. The current Office Action indicates that claim 80 is allowable. Claims 57, 76, and 78 are amended to further clarify the claimed subject matter and correct minor informalities. No new matter is added by the amendments.

The current Office Action rejects claims 57-79 under 35 U.S.C. § 103(a) as being unpatentable over Funk, U.S. Patent No. 5,832,463 (hereinafter “Funk”), in view of Downs, Jr., U.S. Patent No. 6,654,487 (hereinafter “Downs”) in further view of Guzman, U.S. Patent Application Publication 2003/0182227 A1 (hereinafter “Guzman”).

The current Office Action suggests that claims 57-79 are obvious based on the rationale that prior art elements may be combined according to known methods to yield predictable results. As explained at Section 2143(A) of the Manual of Patent Examining Procedure (MPEP), to provide a prima facie case of obviousness under this rationale, Office personnel must articulate a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference. For at least the following reasons, the cited art fails to disclose or suggest all of the limitations of claims 57-79.

A. Claims 57-75

Among other requirements, claim 57 requires automatically determining, at a computing apparatus, based at least in part on the captured information whether the check is eligible to be converted into an ACH debit by determining whether the check is a consumer check, determining whether the consumer has been notified that the check will be converted into an ACH debit, determining whether the check is associated with a financial institution that does not accept ACH transactions, determining whether the consumer has refused to allow conversion of the check into an ACH debit, and evaluating a length and a position of a MICR line of the check

to determine whether the check can be converted into an ACH debit. Furthermore, claim 57 requires automatically creating, at the computing apparatus, an electronic file that contains the information needed to create an ACH debit when a determination is made that the check is eligible to be converted into an ACH debit because the check is a consumer check, the consumer has been notified, the financial institution accepts ACH transactions, the consumer allows conversion of the check into an ACH debit, and evaluation of the MICR line indicates that the check can be converted into an ACH debit.

The current Office Action does not indicate that Funk in view of Downs in further view of Guzman teaches or suggests these requirements of claim 57. Moreover, during the telephonic interview, the Examiner indicated that he was unable to identify any references that taught similar requirements in claim 80 and that claim 80 was allowable for this reason.

For at least this reason, the current Office Action does not cite references that teach or suggest each of the elements of claim 57. Because the current Office Action does not cite references that teach or suggest each of the elements of claim 57, the current Office Action does not provide a prima facie case of obviousness under 35 U.S.C. § 103(a) against claim 57 or its dependent claims 58-75. Accordingly, Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a) of claims 57-75.

B. Claims 76 and 77

Among other requirements, independent claim 76 requires that in response to receiving the administrative return, automatically determining whether the check is eligible to be converted into an ACH debit by determining whether the check is a consumer check drawn against an account associated with a consumer, determining whether the consumer has been notified that the check will be converted into an ACH debit, determining whether the check is associated with a financial institution that does not accept ACH transactions, determining whether the consumer has refused to allow conversion of the check into an ACH debit, and evaluating a length and a position of a Magnetic Ink Character Recognition (MICR) line of the check to determine whether the check can be converted into an ACH debit. Furthermore, independent claim 76 requires automatically converting, at the computing apparatus, the check into an ACH debit when a

determination is made that the check is eligible to be converted into an ACH debit because the check is a consumer check, the consumer has been notified that the check will be converted into an ACH debit, the financial institution accepts ACH transactions, the consumer has allowed conversion of the check into an ACH debit, and evaluation of the MICR line indicates that the check can be converted into an ACH debit.

Although these requirements of claim 76 are not identical to the requirements of claim 57, the reasoning applied above with respect to claim 57 demonstrates that Funk in view of Downs in further view of Guzman does not teach or suggest each of the elements of claim 76. Because the current Office Action does not cite references that teach or suggest each of the elements of claim 76, the current Office Action does not provide a prima facie case of obviousness under 35 U.S.C. § 103(a) against claim 76 or its dependent claim 77. Accordingly, Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a) of claims 76 and 77.

C. Claims 78 and 79

Among other requirements, independent claim 78 requires transmitting the information to a computing device at a remote location that determines whether the check is eligible to be converted into an ACH debit by determining whether the check is a consumer check drawn against an account associated with a consumer, determining whether the consumer has been notified that the check will be converted into an ACH debit, determining whether the check is associated with a financial institution that does not accept ACH transactions, determining whether the consumer has refused to allow conversion of the check into an ACH debit, and evaluating a length and a position of a Magnetic Ink Character Recognition (MICR) line of the check to determine whether the check can be converted into an ACH debit. Claim 78 also requires receiving, from the remote location, a confirmation when it is determined at the remote location that the check is eligible to be converted into an ACH debit because the check is a consumer check, the consumer has been notified, the financial institution accepts ACH transactions, the consumer allows conversion of the check into an ACH debit, and evaluation of the MICR line indicates that the check can be converted into an ACH debit.

Although these requirements of claim 78 are not identical to the requirements of claim 57, the reasoning applied above with respect to claim 57 demonstrates that Funk in view of Downs in further view of Guzman does not teach or suggest each of the elements of claim 78. Because the current Office Action does not cite references that teach or suggest each of the elements of claim 78, the current Office Action does not provide a prima facie case of obviousness under 35 U.S.C. § 103(a) against claim 78 or its dependent claim 79. Accordingly, Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a) of claims 78 and 79.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Respectfully submitted,
MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: December 19, 2008

/Albert W. Vredeveld/
Name: Albert W. Vredeveld
Reg. No.: 60,315